

REMARKS

Claims 28-56 remain in this application. Claims 1-27 were canceled previously. Applicant respectfully requests reconsideration and review of the application in view of the following remarks.

The Examiner rejected Claims 28-54 under 35 U.S.C. § 103(a) as being unpatentable over Kadaba in view of Werb et al. This rejection is respectfully traversed.

Kadaba discloses a method and system for processing packages designated for special handling. Specifically, Kadaba discloses a package transportation system in which packages are marked with labels bearing a tracking number that may be scanned using suitable scanning devices. This scanning operation may be conducted at various points during the transportation of the package. In the scanning operation, the tracking number is identified and communicated to a computer system maintained by the carrier. This information is then uploaded to a website. A customer may thereby access the website and ascertain the current status of the package, i.e., the identification of locations through which the package has passed on route to its final destination.

The Examiner acknowledges that Kadaba fails to disclose "receiving the first information that is stored in a memory of a RFID tag, said first information including a location on a computer network corresponding to a RFID tag." Moreover, the Examiner acknowledges that Kadaba fails to disclose "interrogating a RFID tag located on said package." To make up for this deficiency, the Examiner proposes the combination of Kadaba with Werb et al. Werb et al. discloses an article tracking system that includes RFID tags.

The Applicant maintains its view that there is no teaching or suggestion in the references to combine the package transportation system of Kadaba with the RFID tags disclosed by Werb et al. Once again, the Examiner has merely selected unrelated prior art references in an attempt to reconstruct Applicant's invention. It is impermissible to use the inventor's disclosure as a "road map" for selecting and combining prior art disclosures. In *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138 (Fed. Cir.

1985), the Federal Circuit noted that “[t]he invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time.” Likewise, in *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992), the Federal Circuit admonished against hindsight reconstruction of an invention in the manner reflected by the present rejections. According to the Federal Circuit:

[I]t is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious. ... This court has previously stated that ‘[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.’

See also *In re Gorman*, 933 F.2d 982, 987 (Fed. Cir. 1991) (“As in all determinations under 35 U.S.C. § 103, the decisionmaker must bring judgment to bear. It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant’s structure as a template and selecting elements from references to fill the gaps.”)

In response to this argument, the Examiner states that “it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant’s disclosure, such a reconstruction is proper.” Respectfully, this is not an accurate statement of the law.

The examination approach suggested by the Examiner falls squarely into the impermissible use of hindsight proscribed by the Federal Circuit. Particularly, the Examiner used the present patent application as a template and selected the Kadaba and Werb et al. references solely for their teaching of selected aspects of the claimed invention. There is nothing in the references themselves or elsewhere in the knowledge of the prior art that suggested a combination of these references. The Federal Circuit is

unambiguous in its admonition against "hindsight reconstruction of the claimed invention," and does not recognize as permissible the "reconstruction based upon hindsight reasoning" relied upon by the Examiner.

The Federal Circuit has further stated that "the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is a *rigorous application* of the requirement for a showing of the teaching or motivation to combine prior art references." *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999) (emphasis added). In this regard, the Examiner's analysis falls woefully short.

The Examiner states that "Werb teaches that RFID tags are a known improvement to those skilled in the art as a replacement for bar codes." (emphasis in original). Even if true, this general statement hardly satisfies the "rigorous application" standard mandated by the Federal Circuit. Werb does not say that a bar code data communication methodology of the type disclosed by Kadaba would be applicable to RFID systems, nor does it say that bar code data communication technologies can be modified for use with RFID systems, nor does it say that it would be desirable to use bar code data communication technologies with RFID systems, nor even does it say that the technologies are interchangeable. While any of these statements might be sufficient to show teaching or modification to combine references, they are certainly not present here.

As discussed previously, even if such a teaching or suggestion for the proposed combination were present, the cited references fail to disclose any claim of the present invention. Kadaba discloses that a tracking number is read by a scanner from a label affixed to a package, and the tracking number is communicated to a computer system. The tracking number is then used by the computer system to update a website containing status information for the package. Kadaba does not disclose the manner in which the address for the website is selected or communicated to the user.

Significantly, the tracking number is *not* an address identifying a location on a computer network--it is merely an identifier for the package. When the computer

system of Kadaba encounters a tracking number it does not recognize, it has no way to access information on a network corresponding to the tracking number. In contrast, in the present invention, when an RFID tag having an embedded address is encountered, the scanner can readily access the file on the network associated with the RFID tag—even if the data collection system had never previously encountered this RFID tag. This is because the address information stored in the RFID tag tells the scanner where to look for the information on the network. This is inherent in the nature of network addresses. Kadaba completely fails to disclose how a computing device could use the tracking number to automatically access information on a network relating to the package. Werb et al. fails to make up for this significant deficiency of Kadaba, and the Examiner does not show how this capability would have been suggested to those of ordinary skill in the art.

More specifically, the proposed combination of references fails to suggest or disclose a method for reading an RFID tag that includes, *inter alia*, the steps of “receiving first information stored in a memory of said RFID tag, said first information including an address identifying a location on a computer network corresponding to said RFID tag ... [and] communicating with said location identified by said address,” as defined in Claims 28 and 50. The proposed combination of references further fails to suggest or disclose a computer network system for reading RFID tags that includes, *inter alia*, “an RFID tag ... having a memory containing at least an address identifying a location on a computer network,” as defined in Claim 43. The rejection of Claims 28-54 based on the cited prior art should therefore be withdrawn.

The Examiner also rejected Claims 55-56 under 35 U.S.C. § 103(a) as being unpatentable over Werb et al. This rejection is respectfully traversed.

As discussed above, Werb et al. discloses an article tracking system that includes RFID tags. The Examiner acknowledges that “Werb does not disclose wherein said memory including a data filed containing an address identifying a location on a computer network corresponding to said RFID tag.” Instead, the Examiner concludes

without substantive support that such a data field would be obvious to persons having ordinary skill in the art. Applicant respectfully disagrees, and maintains that the Examiner has not made a *prima facie* case that such teaching would be obvious. To the contrary, the reference fails to suggest or disclose an RFID tag that includes, *inter alia*, "a memory ... including a data field containing an address identifying a location on a computer network corresponding to said RFID tag," as defined by Claim 55.

In view of the foregoing, the Applicant respectfully submits that Claims 28-56 are in condition for allowance. Reconsideration and withdrawal of the rejections is respectfully requested, and a timely Notice of Allowability is solicited. If it would be helpful to placing this application in condition for allowance, the Applicant encourages the Examiner to contact the undersigned counsel and conduct a telephonic interview.

While the Applicant believes that no fees are due in connection with the filing of this paper, the Commissioner is authorized to charge any shortage in the fees, including extension of time fees, to Deposit Account No. 50-0639.

Respectfully submitted,



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